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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,394	09/08/2003	William J. Mertz	1248 P 122	9357

23424 7590 11/08/2006

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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/657,394	<b>Applicant(s)</b> MERTZ ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 to 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1 to 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended the claim to include the language "minimal or substantially no silicone transfer" but it is not clear from the claim or the specification what is embraced by the subjective terms "minimal" and "substantially no". In fact, the distinction between "minimal" and "substantially no" is not even clear. Since the breadth of these terms is unclear, the metes and bounds of the claims and the weight afforded to this language are indefinite.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. '356.

This rejection relies on the rationale noted in previous office actions. As such this will not be repeated. Applicants repeat many of the arguments and statements made in their previous response. These arguments, as well as newly presented ones, fails to establish that the claimed release liner is inherently different from, and unobvious over, that taught in the prior art.

Applicants state that they disagree with the Examiner's previous statement that "all of the advantages of applying the composition in a solvent, as argued by applicants, will inherently be found in the composition of Leir et al.". Although applicants state that they disagree with this statement they proceed to argue the point of solvent removal. This has nothing to do with the Examiner's point of *applying* in a solvent.

Applicants state that the act of "passive" evaporation versus "actively driving off" the solvents that results in a product having the desired properties. On one hand, applicants have not established this with comparative data against the closest prior art. In addition, there are variables in these processes that could result in different properties. For instance, "passive" evaporation over a period of, say, 5 hours may not necessarily

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result in a different product than "actively driving off" solvents for a period of, say, 5 minutes. Furthermore, since Examples 31 and 32 state "solvent evaporation", in lack of anything else it is reasonable to expect complete solvent removal. In that case, the manner by which the solvent is removed would not appear to make a difference. On the other hand, as noted in the previous office action, it is known that applying heat and circulating air results in increased solvent evaporation and doing so in an effort to improve the degree and/or rate of solvent evaporation in Examples 31 and 32 would have been obvious to the skilled artisan. Thus even if the process by which applicants obtain their product is different, this difference does not appear to be unobvious.

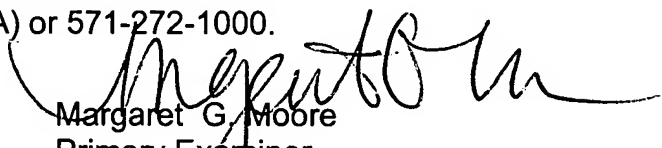
Regarding the examples that use a reactive diluent and no solvent, note that reactive diluent would act like a solvent for the purposes of applicants' alleged benefits of applying the composition with a solvent (i.e. the argued benefit of smoother surfaces, better uniform coating and better adhesion). In addition, such a composition will not have any residual "solvent" since no solvent is present. And, as noted by applicants, the intent is that the reactive diluent will react with the polymer network. Thus the examples that do not include a solvent also appear to inherently meet that claimed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
11/6/06